

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

APL-P3153

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/676,572

Filed

30 September 2003

First Named Inventor

Stuart D. Cheshire

Art Unit

2455

Examiner

Hamza, Faruk

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Anthony Jones/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Anthony Jones

Typed or printed name

☒ attorney or agent of record.
Registration number 59,521

530-759-1666

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

27 September 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 1.15. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Application Number : 10/676,572
Applicant : Stuart D. Cheshire
Filed : 30 September 2003
T.C./A.U. : 2455
Examiner : Hamza, Faruk

Confirmation Number: 7890

Docket Number : APL-P3153
Customer No. : 62096

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant respectfully requests a pre-appeal-brief conference to review the rejection of the above-referenced patent application under 35 U.S.C. § 103 as being obvious based on Jonsson et al. (U.S. Patent No. 7,164,885, hereinafter “Jonsson”) in view of Lumsden (U.S. Pub. No. 2003/0026410, hereinafter “Lumsden”).

I. STATUS OF APPLICATION

In the Official Action mailed on 28 June 2010 (hereinafter “0610 OAR”), the Examiner reviewed claims 1, 5-9, 13-16, 21-24, 35-37, and 41-43. The Examiner rejected claims 1, 8-9, 16-17, 24, 35-37, and 41-43 under 35 U.S.C. § 103(a) based on Jonsson in view of Lumsden.

II. REMARKS AND ARGUMENTS

In rejecting the independent claims in the instant application, the Examiner argues as follows (using the rejection of claim 1 as exemplary):

As to claim 1, **Jonsson** teaches a method for invalidating a resource record in a local cache at a client computer system within a network, comprising: receiving a message from a second client querying a device; locating a second resource record associated with the second device; waiting for a response to the multicast query; and if after a pre-determined number of

queries the response to the query is not received in the pre-determined amount of time, invalidating the second resource record (Column 8, lines 1-Column 9, lines 8).¹ [*sic*]

Applicant respectfully disagrees with the rejection. The rejection is incorrect because the Examiner has not properly established a prima facie case of obviousness. More specifically, the Examiner has impermissibly modified the principles of operation of the Jonsson prior art reference,² and has not adequately explained the gap between the Jonsson reference and the claimed embodiments.³ In the following paragraphs, Applicant explains the problems with the rejections based on Jonsson.

Jonsson describes a system for neighbor selection and connection in Bluetooth (BT) devices.⁴ In the Jonsson system, a BT device maintains a list of neighboring devices with which the BT device can form a connection for accessing a service.⁵ The BT device orders the list according to which neighboring device provides a more desirable version of the service (e.g., provides the highest-bandwidth connection). In the Jonsson system, the list is generated using the well-known BT communication mechanisms described in the following example.⁶ Note that, for this example, we name the device forming the list the “initiator device,” and the neighboring devices “device *n1*” and “device *n2*.”

1. Initiating device, which is looking for service *A*, sends an INQUIRY message.

¹ see 0310 OA, pages 3-5

² see Manual of Patent Examining Procedure (MPEP) § 2143.01(VI): “*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.*”

³ see MPEP § 2141(III) “*The gap between the prior art and the claimed invention may not be ‘so great as to render the [claim] nonobvious to one reasonably skilled in the art.’*”

⁴ see Jonsson, col. 6, lines 30-35

⁵ see at least *id.*, col. 2, lines 22-25, col. 6, lines 30-35 and 38-42, and col. 8, lines 23-29

⁶ see *id.*, col. 8, lines 15-50 for Jonsson’s explanation of the operations in this example

2. Initiating device receives separate INQUIRY RESPONSE messages from device *n1* and device *n2* that provide service *A*.
3. Initiating device connects to device *n1* and sends an SDP message to device *n1* to determine device *n1*'s service *A* capabilities.
4. Initiating device connects to device *n2* and sends an SDP message to device *n2* to determine device *n2*'s service *A* capabilities.
5. Initiating device places device *n1* and device *n2* into an ordered list according to which device provides a more desirable version of service *A*.

Although presenting this sequence of operations for generating a candidate list in an initiating device, Jonsson nowhere describes the other devices (i.e., devices *n1* and *n2*) communicating with each other or somehow understanding what is being communicated between the initiating device and the other neighboring device. In fact, Jonsson expressly describes how **each BT piconet can only include one “master” unit/device** (which, in the example case above, would be the initiating device) and the rest of the devices in the piconet must be slaves.⁷ Jonsson's slave devices **cannot communicate directly with one another**:

According to Bluetooth technology **a slave unit can only communicate directly with a master unit**. FIG. 2 illustrates a piconet 200 with a master unit 201 and a plurality of slave units 202-208 arranged in a star network topology. If slave unit 202 wishes to communicate with slave unit 206, slave unit 202 would transmit the information it wished to communicate to master unit 201. Master unit 201 would then transmit the information to slave unit 206.⁸

Thus, because a slave is limited to responding to the master device, the response of one of the devices cannot be detected or otherwise received by the other device. Therefore, Jonsson cannot disclose both “receiving a multicast message from a second client querying a device” and “waiting for a multicast response from the device to the multicast query,” because one of the devices will

⁷ see *id.*, col. 3, lines 50-53

⁸ see *id.*, col. 3, lines 54-62

necessarily be a slave -- and therefore cannot communicate directly with both of the two other devices in the piconet.

In addition, a careful reading of Jonsson reveals that the initiating device (i.e., the only device in the Jonsson system that sends a “multicast” message -- the INQUIRY message) in the Jonsson system *always* sends multiple INQUIRY messages in an attempt to keep the list of candidate devices up to date:

While the PDA is connected to the Internet, the evaluation of potential service providers continues as a background activity. Thus, at T7, the PDA transmits another INQUIRY message.⁹

Thus, the Jonsson system would always fail the condition “when a predetermined number of multicast messages from the second client querying the device have been received **without receiving a multicasted response from the device to the second client**, invalidating the resource record associated with the device” because, as described above, the communication from the client in response to the INQUIRY from the master is necessarily directly and only communicated to the master and cannot be detected by the other client.

To summarize, the system described by Jonsson requires that slaves only communicate with masters, of which there is only one in a given piconet. For this reason, all of the “receiving” operations in the claimed embodiments cannot be described in Jonsson. In addition, Jonsson describes a system where multiple INQUIRY messages are always sent, and wherein the devices cannot detect each other’s responses to the INQUIRY message. Therefore, the elements of the Jonsson system would be non-functional in the claimed embodiments.

Because the Examiner has not explained the gap between the Jonsson reference and the claimed embodiments, and because the Examiner has proposed modification or combination of the Jonsson reference that would change the

⁹ see *id.*, col. 8, lines 30-39

principle of operation of Jonsson, the rejection under 35 U.S.C. § 103 based on Jonsson in view of Lumsden is impermissible.

III. CONCLUSION

Because Jonsson nowhere describes the claimed embodiments, Applicant respectfully avers that the combination of Jonsson and Lumsden proposed by the Examiner cannot be used as the basis for a rejection under 35 U.S.C. § 103. Applicant therefore respectfully requests the withdrawal of the rejection under 35 U.S.C. § 103 and the allowance of all the claims in the instant application.

Respectfully submitted,

By /Anthony Jones/
Anthony Jones
Registration No. 59,521

Date: 27 September 2010

Anthony Jones
Park, Vaughan & Fleming LLP
2820 Fifth Street
Davis, CA 95618-7759
Tel: (530) 759-1666
Fax: (530) 759-1665
Email: tony@parklegal.com